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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,273	12/19/2000	Paul Kotas	249768028US1	7099

25096 7590 06/27/2006

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/742,273	KOTAS, PAUL	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAGDISH PATEL	3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 9-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to amendment filed 4/12/06.

#### ***Response to Amendment***

2. No Claims have been amended, added or cancelled.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-8,29 and 30 have been considered.

Accordingly rejection of said claims under 35 USC 103 (a) has been withdrawn.

### **Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility a claimed invention must satisfy the requirement that it be

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directed to a "practical application" which is to mean "the claimed invention physically transforms an article or physical object to a different state or thing, or ... the claimed invention otherwise produces a useful, concrete, and tangible result".

If a claim satisfies those questions, then the claim describes eligible subject matter. In the instant case the claimed invention does not physically transform an article or a physical object to a different state or thing since the claim is not directed to an article or physical object. Therefore, a relevant test to determine eligibility requirement is whether, the claimed invention as a whole is limited to a useful, concrete, and tangible Result.

In the instant case claims 1 and 5 are directed to identifying users to whom to promote a selected auction.

In determining whether the claim is for a "practical application," the focus is on the final result achieved by the claimed invention. If the claim is directed to a practical application of the § 101 judicial exceptions producing a result tied to the physical world (that does not preempt the judicial exception), then the claim meets the statutory requirement of 35 U.S.C. § 101.

Claims 1 and 5 causes identification of the users that bid in the distinguished auction and did not bid in the selected auction. However, the result of the claimed process which identifies users is not tied to a practical application since it is not tied to the physical world. Therefor, the claimed invention(s) fails to meet the practical application requirement under the guidelines for eligibility requirements under 35 U.S.C. 101. (refer

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to Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (the “Guidelines”).

The examiner would like to point out that each of claims 2-4 and 6-8 meet the practical application requirements under the guidelines.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orr, Alicia; 'Best ideas' for fund raising by phone , Target Marketing v21n9 PP: 48-51 Sep 1998.

Claims 29 and 30 recite a method and (corresponding system) which promotes a first auction in which a first user has a bid based upon identifying that a second bidder has bid in a second auction along with the first bidder, and that said second bidder has not bid in the first auction.

This protocol of protocol of promoting an event (such as a “donation campaign”) to one or more donors who have donated (or participated) in the past campaigns (inherently wherein other donors have also donated) but not donated in the recent donation campaign is old and well known as exemplified in the cited prior art. Orr teaches a method of soliciting participation in current donation event (analogous to the first auction) to one or more participants (second

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user(s) who have participated in the past donation event (analogous to the second auction)).

Inherently, and obviously, other participants also have participated in the past as well as in the current donation events (analogous the first user having a bid in the first auction and the second auction).

The cited reference addresses the problem the applicant was concerned with, namely that of promoting an event (in the claimed invention this is auction) to the user who along with other user has participated in the previous event (of same characteristics, other auction). Both the reference and the subject deals with promoting certain event to a user who meets certain criteria. In this regard, not only that they attempt to solve similar problem but that the prior art cited herein is analogous art. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

The cited prior fails to teach the method as being performed by a computer system. Official Notice is taken that implementation of auctions and promotions of events over a computer system is old and well known.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the method for promoting a first auction in a computer system. Motivation for computer implantation is that the method would be performed efficiently than manual operations, such method would also enable benefits of electronic mailing for promotions which can be reached at large number of users, reducing cost of operations.

***Allowable Subject Matter***

4. Claims 2-4 and 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Conclusion***

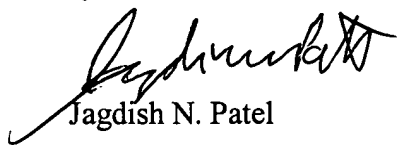
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

6/22/06